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MAY 24 2002 U.S. Application No. 09/881,097
Attorney Docket No. 05725.0905-00

TECH CENTER 1600/2900

The Examiner states that the inventions are not related since the composition of Group I can be removed by a method other than that claimed in the claims of Group II. See page 2 of the present Office Action.

Applicants refer this Examiner to M.P.E.P. § 803, which sets forth the criteria and guidelines for Examiners to follow in making proper requirements for restriction. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining both groups together would constitute a serious burden. The process defined in claims 57 and 58 utilizes the composition defined in claim 1 as part of the make-up removing method. Applicants respectfully submit that a search of the subject matter of Group I, in addition to the subject matter of Group II, would not be burdensome because a search of the subject matter of Group I would appear to encompass the search of the subject matter of Group II since all claims recite the composition set forth in claim 1. Accordingly, a search for these groups of claims should substantially overlap. Thus, for at least this reason, Applicants respectfully submit that the restriction requirement is in error and

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request that the requirement be withdrawn.

B. Election of Species Requirement

The Examiner has also required an election of a single disclosed species of the claimed invention from: (a) film forming polymers encompassed by claims 24 and 25, and (b) thermal transition agents encompassed by claim 11, 15, and 19.

Applicants elect with traverse, (a) polyurethane film forming polymers (claim 24) and (b) at least one thermal transition agent chosen from polymers with a hydroxyl number of at least 5 (claim 15) such as polycaprolactones (claim 19). The elected subject matter reads on at least claims 1-10, 15-19, 21-56, and 59. Eight thermal transition agents chosen from polymers with a hydroxyl number of at least five are disclosed in Examples 1-8. A composition for keratinous material, a mascara, is disclosed, for example, in Example 9.

Applicants traverse this election of species requirement on the grounds that the Examiner has not provided sufficient reasons for requiring the election of species. In support of the election requirements, the Examiner must show that the species subject to election are patentably distinct. 37 C.F.R. § 1.146. In the present case, the Examiner simply concluded that “[t]he application contains claims directed to patentably distinct species.” See page 3 of the Office Action. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application.

If the Examiner chooses to maintain the election requirement, however, and the elected species is found to be allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to

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determine the patentability thereof, i.e., extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, she is invited to call the undersigned at (202) 408-4162.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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